

Applicant : David Stern
Serial No. : 09/682,837
Filed : 10/23/01
Page : 2

Attorney's Docket No.: 3371.1

60/242,859 filed October 24, 2000 and Serial No. 60/244,817 filed October 31, 2000, both of which are hereby incorporated by reference herein in their entireties for all purposes.—

In the Claims:

Please cancel, without prejudice, claims 1 and 21-35.

RECEIVED

JAN 28 2003

TECH CENTER 1600/2900

REMARKS

Claims 2-20 have been examined and all stand rejected. Claims 1 and 21-35 are subject to a final restriction requirement. In response to this final restriction requirement, Applicant now cancels claims 1 and 21-35 so that they may be prosecuted in a continuation or divisional application. No new matter is included in this Amendment, no claims have been added or canceled, and thus no additional claim fees are due as a result of this Amendment. Attached hereto as Appendix A captioned "Version with Markings to Show Changes Made" is a marked-up version of the changes made to the specification by the current amendment.

Election of Group II without traverse

In view of the Examiner's decision in the Office Action of 9/17/02 to make the restriction requirement final, Applicant hereby retracts his election of claims 2-20 with traverse and now elects claims 2-20 without traverse.

Amendment of the Specification

The specification has been amended so that priority is claimed only to U.S. Provisional Patent Application Serial No. 60/242,975.

Claim Rejections – 35 USC §102(b)

Claims 2, 3, 5-12, and 16-20 have been rejected under 35 USC §102(b) as being anticipated by Rava, *et al.*, U.S. No. 5,545,531. Applicant respectfully traverses these rejections and requests reconsideration.

Rava describes methods for concurrently processing multiple biological chip assays by "providing a biological chip plate comprising a plurality of test wells, each test well having a biological chip having a molecular probe array; introducing samples into the test wells;

subjecting the biological chip plate to manipulation by a fluid handling device that automatically performs steps to carry out reactions between target molecules in the samples and probes; and subjecting the biological chip plate to a biological chip plate reader that interrogates the probe arrays to detect any reactions between target molecules and probes.” (Abstract.) Various methods for forming test wells are described (e.g., col. 2, lines 46-61). The term “biological chip plate” is stated as being intended to have the following general meaning: “A device having an array of biological chips in which the probe array of each chip is separated from the probe array of other chips by a physical barrier resistant to the passage of liquids and forming an area or space, referred to as a ‘test well,’ capable of containing liquids in contact with the probe array.”

Independent claim 2 is directed to a multi-array scanning system for scanning a plurality of microarrays disposed on a substrate. The system includes a scanner apparatus that detects emission signals from at least two of the plurality of microarrays. The system also includes “a convertible processing apparatus including one or more containing members constructed and arranged to contain the substrate and a separating member constructed and arranged so that, when the separating member is disposed in a first position with respect to the containing members, the at least two microarrays are fluidically separated from each other by the separating member, and, when the separating member is disposed in a second position with respect to the containing members, the at least two microarrays are fluidically coupled with each other.” The Examiner states that these elements of claim 2 are to be found in Rava at column 5, lines 16-65, column 8, lines 1-5. Applicant respectfully disagrees and asserts that these elements are neither taught nor suggested at the indicated places or elsewhere in Rava.

Because elements of claim 2 are missing from Rava, claim 2 is patentable. Moreover, since claims 3-20 all depend from claim 2, they also are patentable for at least the same reasons stated above with respect to claim 2. Applicant therefore requests that the rejections of claims 2-20 as anticipated by Rava under 35 USC §102(b) be withdrawn.

Claim Rejections – 35 USC §103(a)

Claims 13-15 have been rejected under 35 USC §103(a) as being unpatentable over Rava, *et al.*, U.S. No. 5,545,531 in view of Schembri, *et al.*, U.S. No. 6,258,593. Applicant respectfully traverses these rejections and requests reconsideration.

Claim 13 depends directly from claim 2 and further recites that “the one or more containing members include a first segment and a second segment in contact with the first segment, wherein the substrate is disposed between the first and second segments.” Claim 14 depends directly from claim 13 and adds that “the separating member is disposed between the first and second segments when the separating member is in the first position, and is disposed apart from the first and second segments when the separating member is in the second position.” Claim 15 also depends directly from claim 13 and adds that “the substrate is retained in place by the first and second segments.”

As noted above, Rava neither teaches nor suggests, among other things, the elements of claim 2 from which claims 13-15 derive directed to: “a convertible processing apparatus including one or more containing members constructed and arranged to contain the substrate and a separating member constructed and arranged so that, when the separating member is disposed in a first position with respect to the containing members, the at least two microarrays are fluidically separated from each other by the separating member, and, when the separating member is disposed in a second position with respect to the containing members, the at least two microarrays are fluidically coupled with each other.” Nor does Schembri teach or suggest these elements, and the Examiner does not suggest as much. Rather, Schembri generally is directed to “providing an apparatus for conducting chemical or biochemical reactions on a solid surface within an enclosed reaction chamber.” (Col. 4, lines 28-30.) Because at least the above-quoted elements of claims 13-15 are lacking in either reference, and consequently in their combination, the claims are not rendered unpatentable as being obvious in view of the combination. Applicant therefore requests that the rejections of claims 13-15 under 35 USC §103(a) as being unpatentable over Rava in view of Schembri be withdrawn.

Claim Rejections – Obvious-Type Double Patenting

Claims 2-20 have been rejected under the judicially created doctrine of obvious-type double patenting over claims 1-25 of U.S. Patent No. 5,981,956 to Stern, and also over claims 1-25 of U.S. Patent No. 6,207,960 to Stern, and also over claims 1-18 of U.S. Patent No. 6,025,601 to Trulson, et al., in view of U.S. Patent No. 5,981,956 to Stern. Applicant respectfully traverses these rejections and requests reconsideration.

The Examiner states that, with respect to each of the patents asserted as a ground for rejection, the “sets of claims differ only in the instant claims recite scanning a plurality of microarrays and detecting emission from at least two of the plurality of microarrays.” Applicant respectfully disagrees. Among other things, none of the sets of claims in the patents referred to by the Examiner include the following elements of the instant claims: “a convertible processing apparatus including one or more containing members constructed and arranged to contain the substrate and a separating member constructed and arranged so that, when the separating member is disposed in a first position with respect to the containing members, the at least two microarrays are fluidically separated from each other by the separating member, and, when the separating member is disposed in a second position with respect to the containing members, the at least two microarrays are fluidically coupled with each other.” Applicant therefore requests that the rejections of claims 2-20 under obvious-type double patenting be withdrawn.

Claim 4 as Free of Prior Art of Record

Applicant acknowledges the Examiner’s statement that claim 4 is free of the prior art of record and could be placed in condition of allowance following resolution of rejections. Applicant understands the Examiner to be referring to the rejections based on obvious-type double patenting. In view of the Applicant’s reasoning with respect to this ground for rejections as stated above, Applicant believes that claim 4 is presently in condition for allowance and respectfully requests such action.

CONCLUSION

Applicant respectfully submits that this Amendment addresses all of the outstanding rejections, thereby placing the application in condition for immediate allowance. Allowance of this application is therefore respectfully requested.

Applicant’s undersigned attorney requests an opportunity to interview this case with the Examiner at the Examiner’s convenience. Applicant’s undersigned attorney will contact the Examiner for this purpose.

If any fees are necessary to enable entry and consideration of this Amendment, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 01-0431. If

Applicant : David Stern
Serial No. : 09/682,837
Filed : 10/23/01
Page : 6

Attorney's Docket No.: 3371.1

an extension of time is needed that is not accounted for in the papers filed with this Amendment, then the extension is hereby requested. The necessary extension fee also may be charged to Deposit Account No. 01-0431.

Respectfully submitted,



Alan B. Sherr
Reg. No. 42,147

Date: January 17, 2003

Affymetrix, Inc.
3380 Central Expressway
Santa Clara, CA 95051
781-280-1712

APPENDIX A
VERSION WITH MARKINGS TO SHOW CHANGES MADE

The first paragraph of page 1 of the specification under "Related Applications" has been amended as follows:

The present application claims priority from U.S. Provisional Patent Application[s] Serial No[s]. 60/242,975 [and 60/242,859, both]filed October 24, 2000, [and both]hereby incorporated by reference herein in [their entireties]*its entirety* for all purposes[; and from]. *The present application relates to U.S. Provisional Patent Applications Serial No. 60/242,859 filed October 24, 2000 and Serial No. 60/244,817[,] filed October 31, 2000, both of which are hereby incorporated by reference herein in their entireties for all purposes.*